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**DATE:** January 16, 2007

**PTO IDENTIFIER:** Application Number 10/002,952-Conf. #5464

Patent Number

**Inventor:** Nobuyuki Takamori et al.

**MESSAGE TO:** US Patent and Trademark Office

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**PAGES (Including Cover Sheet):** 8

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Application No. (if known): 10/002,952

Attorney Docket No.: 56710(70801)

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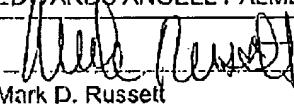
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Application Number	10/002,952-Conf. #5464		
Filing Date	November 15, 2001		
First Named Inventor	Nobuyuki Takamori		
Art Unit	1756		
Examiner Name	M. J. Angebranndt		
Total Number of Pages in This Submission	8	Attorney Docket Number	56710(70801)

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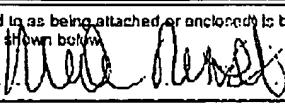
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Attorney Docket No. 56710 (70801)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of:  
Nobuyuki Takamori et al.

Application No.: 10/002,952

Confirmation No.: 5464

Filed: November 15, 2001

Art Unit: 1756

For: OPTICAL DATA RECORDING MEDIUM

Examiner: M. J. Angebrannen

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Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**REPLY BRIEF PURSUANT TO 37 C.F.R. §41.41**

Sir:

This is a Reply Brief in response to the Examiner's Answer mailed from the U.S. Patent and Trademark Office on November 14, 2006. This paper is filed within two months of the date of the Examiner's Answer (January 14 and 15 being, respectively, a Sunday and a federal holiday in the District of Columbia), and is therefore believed to be timely filed.

**FEES**

It is believed that no fee is required in connection with the filing of this Reply Brief. However, if for any reason a fee is required, a fee paid is inadequate or credit is owed for any excess fee paid, the Commissioner is hereby authorized and requested to charge Deposit Account No. 04-1105.

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## ARGUMENT

### I. Introduction

On August 23, 2006, Appellants submitted their Brief on Appeal in connection with the above-referenced application. On November 14, 2006, the Examiner's Answer to that Appeal Brief was mailed from the U.S. Patent and Trademark Office. Appellants disagree with the Examiner's position on several issues, but, to the extent that the issues have been fully discussed in the Appeal Brief, will not revisit those positions. However, the Examiner has emphasized certain points in his Examiner's Answer, and Appellants submit this Reply Brief to respond to these points.

### II. The Examiner's Characterization of the Tajima Reference is Erroneous

Throughout the prosecution of this application, the Examiner has maintained that the teachings of one or more references inherently anticipate the pending claims. In the Examiner's Answer, the Examiner maintains the rejection of record from the final Office Action dated August 23, 2005, to wit, that the pending claims are allegedly anticipated (inherently) and therefore unpatentable under 35 USC §102(b) over JP 2000-311381 to Tajima *et al.* (hereinafter "Tajima"). Appellant has previously responded to the Examiner's contentions; however, in the Examiner's Answer, the Examiner has provided additional remarks, to which Appellants now respond.

In the section titled "Response to Argument" (Section 10 of the Examiner's Answer), the Examiner has reiterated his view that Figure 10 of the cited Tajima reference inherently discloses a medium meeting the limitations of the claims. In essence, the Examiner argues that, if the medium described in Figure 10 of the Tajima reference has the disclosed value for warpage, then

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the expansion coefficient under humidity of that medium must meet the limitations of the present claims. See, e.g., pages 5 and 6 of the Examiner's Answer. The following remark apparently summarizes the Examiner's position:

The applicant has not provided a logical framework which would allow the results shown in figure 10 [of the Tajima reference] for the medium disclosed, where the relative humidity is changed by 30%, but the warpage is only ~1mtad, to be achieved with a coefficient of expansion due to humidity outside the values recited in the claims.

Examiner's Answer at page 6, lines 16-19.

Appellants cannot agree with this proposition. As an initial matter, Appellants point out that establishing a *prima facie* case of anticipation is the burden of the Examiner. It is not Appellants' burden to provide a "logical framework" as suggested by the Examiner.

In any event, the Examiner argues that the warpage or deflection value described in Example 4 of Tajima is similar to the warpage described for embodiments of the present invention as described in the subject specification. See, e.g., Examiner's Answer at page 4, lines 3-7 and 10-13. It appears to be the Examiner's position that the thin protective film of Example 4 of Tajima inherently meets the requirements of the pending claims, and that, in Tajima, a "result effective property" has been optimized and is "within the preferred range recited in the [presently-pending] claims." See Examiner's Answer at page 6, lines 8-16.

Appellants do not agree. Although the Examiner states that the properties of the presently-claimed media and the media disclosed in the Tajima reference are the same, it is Appellants' position that media having similar deflection values as a whole need not have identical properties, e.g., need not have identical Young's modulus, expansion coefficient under humidity, thickness, etc. Indeed, the values of the various properties can be varied to provide a desired result, and variation in the value of one property may require change in a different property in order to obtain a desired result.

For example, the Young's modulus of the substrate of Example 4 of Tajima is defined as  $3.3E+9$  [Pa] (i.e.,  $3.3 \times 10^9$  [Pa] as provided in Table 5 of Tajima). This value is clearly larger

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than that defined in Example 1 and Fig. 11 of the present application (i.e., the Young's modulus of the substrate is  $2.41 \times 10^9$  [Pa]). It will be appreciated that, as a natural result of this larger Young's modulus, the medium described in Tajima has greater stiffness. To obtain a particular warpage under conditions of changing humidity may require that the protective film have different properties depending upon the properties of the substrate, e.g., Young's modulus, expansion coefficient under humidity, thickness, etc. Therefore, the argument urged by the Examiner – that similar warpage or change in the deflection value seen in embodiments of the present invention and in examples of the cited reference is evidence of (other) inherently similar properties – is not supportable.

Inherency "may not be established by probabilities or possibilities." MPEP 2112(IV), citing *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999) (citations omitted). It is not a logical (much less inevitable) conclusion that a protective film as described in the media of Tajima has the same property or properties as a protective film according to the claimed invention simply on the basis that a similar effect in deflection can be produced. On the contrary, a different Young's modulus of the substrate (as described in Tajima) may require a different set of properties of a protective film (e.g., a different expansion coefficient under humidity, etc.) in order to provide an optical data recording medium having the disclosed warpage or deflection.

Because the Examiner has not shown that "the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art," MPEP 2112(IV), citing *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990), the properties of the media as defined by the pending claims are not inherent properties of the media described in Tajima. It follows, then, that the pending claims are not anticipated by the Tajima reference. Appellants respectfully request that the Board reverse the decision of the Examiner and the rejection of the pending claims.

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### SUMMARY

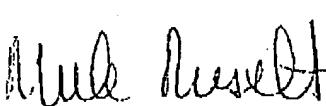
Appellants submit that all of the claims under final rejection are in condition for allowance and should be allowed, and that the Final Office Action should be vacated.

If for any reason a fee is required, a fee paid is inadequate or credit is owed for any excess fee paid, you are hereby authorized and requested to charge Deposit Account No. **04-1105**, under Reference No. 56710 (70801), Customer No. 21874.

Respectfully submitted,

Date: January 16, 2007

By: \_\_\_\_\_

  
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